

THE JOINT EXAMINATION BOARD

PAPER T5

BASIC OVERSEAS TRADE MARK LAW AND PRACTICE

15th November, 1993

3.00 p.m. - 5.00 p.m.

Please read the following instructions carefully. This is a TWO HOUR paper.

1. You should attempt no more than eight questions from Part A and no more than five questions from Part B.
2. The number of marks allotted to each question is placed in brackets at the end of the question.
3. Where a question permits of reasons being given for the conclusions reached, such reasons should be given.
4. Start each question (but not necessarily each part of each question) on a fresh sheet of paper. In the appropriate boxes at the top of each sheet please enter the designation of the paper, the question number, and your Examination number. Write on one side of the paper only using BLACK ink. You must NOT staple pages together. You must NOT state your name anywhere in the answers.
5. Unless specifically requested answers are NOT required in letter form.
6. NO printed matter or other written material may be taken into the examination room.
7. Answers MUST be legible. If the examiners cannot read a candidate's answer no marks will be awarded.

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PART A

1. Your client has obtained registration of their Trade Mark in respect of computer software in the following countries.

Austria    Canada    France    Portugal    Switzerland

Your client now instructs you to obtain registration of the exact same Trade Mark in these same countries in respect of Computer Programming Services. What action would you take to obtain the statutory protection which your client requires in these countries?

(5 marks)

2. Write brief notes on the opposition procedure in France.

(5 marks)

3. In which of the following countries is it possible to register a three-dimensional shape as a Trade Mark?

Japan    New Zealand    South Africa    Switzerland    U.S.A.

(5 marks)

4. In many countries it is possible to register Certification Trade Marks and Collective Marks. Without reference to any particular country, write brief notes on each of these.

(5 marks)

5. In the United States an affidavit of use may be filed under section 15 of the Lanham Act. What is the purpose of this affidavit and how does it compare to an affidavit filed under section 8 of the Lanham Act?

(5 marks)

6. A UK company has a French subsidiary which owns International Registrations under the Madrid Arrangement. Write brief notes on the principal disadvantages of this policy compared with obtaining national registrations in "Madrid countries" in the name of the UK company.

(5 marks)

7. In which EC countries, outside the UK, is an application for cancellation of a Trade Mark registration by a third party decided at the Trade Marks Registry/Tribunal and in which is an application for cancellation decided in the courts?

(5 marks)

8. Explain briefly the EC doctrine of "exhaustion of rights".

(5 marks)

9. In most countries, a Trade Mark may be struck off the register on the grounds that the mark has not been used for a certain period. What is the "non use" period in the countries set out below?

Australia	Benelux	France	Germany	Ireland
Italy	Japan	Norway	Switzerland	U.S.A.

(5 marks)

#### PART B

10. In order to file a valid Trade Mark application a proprietor must fulfill certain conditions. Compare and contrast such pre-conditions for applying to register a Trade Mark in the United States and Canada.

(12 marks)

11. Prior Rights Agreements are common in European countries outside the UK and Ireland. What are they? When might they be required? Outline the key features you would include.

(12 marks)

12. There have been two decisions of the European Court of Justice relating to the CAFE HAG Trade Mark. Write brief notes on the two decisions.

(12 marks)

13. Write brief notes on written agreements, the effect of which is to restrict the free movement of goods under EC law.

(12 marks)

14. Your client, a large UK company, has recently re-organised as a result of which they have decided to assign all of their Trade Mark applications and registrations to their parent company Trade Mark Holdings plc. The Trade Marks are registered or applied for in each of the EC countries. Your client has forwarded to you a draft of an assignment document for approval and you find this to be in a form which is generally considered to be acceptable for the purpose of recording an assignment on the registers of the various EC

countries but the assignment document has not yet been executed.

- (i) How would you advise your client to have the document executed?
- (ii) What further information and documents would you require to enable you to record the assignment on the Trade Marks registers of the EC countries (except the UK)?
- (iii) What problems might you encounter in recording the assignment in these countries?
- (iv) How would you attempt to overcome any such problems?

(12 marks)

15. Describe fully the registration procedure in Germany. (12 marks)